

**REMARKS**

The present amendment is intended to be fully responsive to the Office Action having a mailing date of October 31, 2007. After entry of this amendment, claims 9, 11, 13-16 and 21-34 are pending in the Application. Claims 9, 11, 13-16 and 21-29 have been herein amended. Claims 1-8 and 17-20 have been cancelled without prejudice as being drawn to a non-elected invention. Claims 10 and 12 have also been cancelled without prejudice. Claim 25, previously directed to a non-elected invention, has been amended to depend from independent claim 9. New claims 30-34 have been herein added. Applicant submits that no new matter has been added by this amendment and that support for the claims, as amended and added, may be found throughout the specification and drawings. At least for the reasons set forth below, Applicant respectfully traverses the foregoing rejections. Further, Applicant believes that there are also reasons other than those set forth below why the pending claims are patentable, and accordingly reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers. Applicant respectfully requests reconsideration of the present Application in view of the above amendments, the new claims, and the following remarks.

**Claim Rejections – 35 U.S.C. § 112**

Claim 21 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner contends there is insufficient antecedent basis for the limitation “the tissue receiving opening”. The limitation has herein been amended to read “a tissue receiving opening.” Accordingly, Applicant respectfully requests that the instant rejection be reconsidered and withdrawn.

**Claim Rejections – 35 U.S.C. § 102**

Claims 9, 10, 12, 14, 15 and 21-24 stand rejected under 35 U.S.C. § 102(b), as being anticipated by Warner et al. (U.S. 5,871,487) (hereinafter “Warner et al.”).

A. **Independent Claim 9**

The rejection with respect to claim 9 is respectfully traversed. Notwithstanding, independent claim 9 has been amended to include all of the limitations of dependant claims 10 and 12 (which have herein been cancelled without prejudice), and more particularly, to recited

that the indexing guide includes at least one guide lock. Claim 9 has also been amended to recite that the at least one guide lock is slidably attached to the indexing guide. In contrast, Warner et al. does not anticipate, teach, or suggest the claimed combination of elements, particularly as amended. Warner et al. describes using a screw (38) for holding a cannula within notch (36) of holding member (32) (*see* Warner et al., column 4, lines 44-46). The Examiner contends that screw (38) corresponds to the “guide lock” of claim 9. Screw (38) of Warner et al., however, threadably engages holding member (32), whereas the guide lock of claim 9 slidably engages the indexing guide. Since screw (38) does not (and cannot) slidably engage holding member (32), it is clear that Warner et al. does not anticipate claim 9. Accordingly, it is respectfully requested that the instant rejection be reconsidered and withdrawn.

B. Dependant claims 10, 12, 14, 15 and 21-24

The rejection with respect to claims 10 and 12 is deemed moot in light of the claims having been herein cancelled without prejudice. The rejection with respect to claims 14, 15 and 21-24 is respectfully traversed. Claims 14, 15 and 21-24 are dependent upon independent claim 9. The same arguments made above with respect to claim 9 are equally applicable to dependant claims 14, 15 and 21-24. Nevertheless, these dependent claims also recite independently patentable subject matter.

1. Dependant claim 14

Claim 14 recites that the indexing guide includes a lip adjacent to the receptacle to prevent movement of the medical instrument in a second axial direction. It is respectfully submitted that Warner et al. does not anticipate, teach or suggest the claimed combination of elements. The Examiner contends that the “lip” recited in claim 14 is described in Fig. 1 of Warner et al., but does not identify which portion of the instrument is alleged to correspond to the “lip”. The Examiner states that notch (36) of Warner et al. corresponds to the “receptacle” recited in claim 14. Contrary to the Examiner’s assertion, however, there are no features adjacent notch (36) that could operate to prevent axial movement of a medical instrument disposed within the notch. Instead, axial movement of the medical instrument is prevented by screw (38) engaging the medical instrument and holding it in place. It also appears from Figs. 2-4 of Warner et al. that the medical instrument includes a radially extending shoulder that engages an upper surface of holding member (32) when the medical instrument is located within notch (36). If it were not for these two features, neither of which even remotely constitutes a “lip” as

recited in claim 14, there would be nothing to prevent the medical instrument from being moved axially within notch (36).

2. Dependant claim 15

Claim 15 recites that the cradle includes a pivotable clamp that is selectively engagable with the medical instrument. It is respectfully submitted that Warner et al. does not anticipate, teach or suggest the claimed combination of elements. The Examiner contends that screw (38) of Warner et al. corresponds to the “pivotable clamp” of claim 15. No where does Warner et al. disclose or suggest that screw (38) is pivotably connected to holding member (32) (which the Examiner contends corresponds to the “cradle” of the present invention). Indeed, it does not appear that any of the components of the medical instrument shown in Warner et al. are pivotable.

Accordingly, Applicant respectfully requests that the Examiner’s rejection of claims 9, 10, 12, 14, 15 and 21-24 under 35 U.S.C. § 102(b) as being anticipated by Warner et al., be reconsidered and withdrawn.

Claims 9, 10-12, 14-16 and 21-24 stand rejected under 35 U.S.C. §102(b), as being anticipated by Cooper et al. (U.S. 6,451,027) (hereinafter “Cooper et al.”).

A. Independent Claim 9

The rejection with respect to claim 9 is respectfully traversed. Notwithstanding, independent claim 9 has been amended to include the limitations of dependant claims 10 and 12 (which have been cancelled without prejudice), and more particularly, to recite that the indexing guide includes at least one guide lock that is selectively engagable with the portion of the medical instrument received within the receptacle. Claim 9 has also been amended to recite that the at least one guide lock is slidably attached to the indexing guide. In contrast, Cooper et al. does not anticipate, teach, or suggest the claimed combination of elements, particularly as amended. The examiner contends that mounting formation (22) of Cooper et al. corresponds to the “indexing guide” of claim 9. The Examiner does not, however, identify which feature or component of mounting formation (22) is alleged to correspond to the “guide lock” of claim 9 (the “guide lock” limitation was previously introduced in claim 10, but is now included in presently amended claim 9). Mounting formation (22) includes a collar (50) mounted to a support (52). An endoscope (92) (*see* Fig. 11) having an endoscope locating formation (90) (*see* Figs. 10 and 11) is attached to collar (50) by inserting endoscope locating formation (90) into the opening in collar (50). The endoscope is locked into position by engaging latches (90.3) of

endoscope locating formation (90) with corresponding apertures (no reference number assigned) in collar (50) (*see* Cooper et al., column 9, lines 22-38). Unlike the medical device of claim 9, latches (90.3) used to secure the endoscope to mounting formation (22) are attached to the endoscope, not mounting formation (22), which the examiner contends corresponds to the “indexing guide” of claim 9. Even if it could be argued that endoscope locating formation (90) is part of mounting formation (22) rather than the endoscope, mounting formation (22) still does not include a “guide lock” slidably attached to mounting formation (22) and selectively engagable with endoscope (92). Rather, endoscope locating formation (90) is secured to the endoscope by means of a screw-threaded fastener attachable at location (90.1) of endoscope locating formation (90) (*see* Cooper et al., Fig. 10, and text at column 9, lines 8-21). Accordingly, it is respectfully requested that the instant rejection be reconsidered and withdrawn.

## **II. Dependant claims 10-12, 14-16 and 21-24**

The rejection with respect to claims 10 and 12 is deemed moot in light of the claims having been herein cancelled without prejudice. Claims 11, 14-16 and 21-24 are dependent upon independent claim 9. The same arguments made above with respect to claim 9 are equally applicable to dependant claims 11, 14-16 and 21-24. Accordingly is respectfully requested that the instant rejection be reconsidered and withdrawn.

### **Claim Rejections – 35 U.S.C. § 103**

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Warner et al. (U.S. 5,871,487). The rejection is respectfully traversed. It is submitted that claim 11, which depends directly from claim 9, patently defines over the cited reference for the same reasons as set forth above with respect to the patentability of claim 9. Applicant accordingly requests that the instant rejection be reconsidered and withdrawn.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Warner et al. (US 5,871,487) in view of Moctezuma De La Barrera et al. (U.S. 7,166,144). The rejection is respectfully traversed. It is submitted that claim 13, which depends directly from independent claim 9, patently defines over the cited reference for the same reasons as set forth above with

respect to the patentability of claim 9. Applicant accordingly requests that the instant rejection be reconsidered and withdrawn.

### **New Claims**

New claims 30-34 have been added in this amendment for the Examiner's consideration. It is submitted that the cited references do not anticipate, teach or suggest the invention as recited in new claims 30-34. The Examiner's consideration of new claims 30-34 is requested.

### **CONCLUSION**

All rejections have been addressed. In view of the above, the pending claims are believed to be in condition for allowance over the cited prior art. Accordingly, reconsideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under Order No. 65937-0047 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

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Respectfully submitted,

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